

Restriction Requirement under 35 U.S.C. §121

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-46, drawn to a method of breaking a gel, classified in Class 516, subclass 113.
- II. Claims 27-62, drawn to an aqueous composition, classified in Class 507, subclass 211.

The inventions are alleged to be distinct, each from the other because of the following reasons:

Inventions II and I are allegedly related as a product and a process of use. The inventions are allegedly distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product. In this case, the Examiner contends that the product may be used as a viscous fluid in methods of well treatment or out of the well treatment prior to breaking of the gel.

Because these inventions are allegedly distinct for the reasons given above and have acquired a supposed separate status in the art as shown by their different classification, the restriction for examination purposes as indicated is contended to be proper.

The Applicants hereby elect with traverse the claims 1-46 of Group I, drawn to a method of breaking a gel.

Applicants respectfully traverse the restriction requirement as not complying with the statutory law in this area. Specifically, the Examiner has made no showing that the two sets of claims are "independent *and* distinct." The law states, in 37 CFR §1.142, that:

(a) If two or more *independent and* distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction ... (Emphasis added.)

While there is some difference in the way this statute is interpreted in the MPEP, it should be noted that:

“The MPEP ... is entitled to notice so far as it is an official interpretation of the statutes or regulations with which it is not in conflict.” See *Litton Systems, Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97, 107 (Fed. Cir. 1984).

As the MPEP is in *direct* conflict with the law on this point, it is not entitled to *any* weight on the matter. The Examiner only argues distinctness in the rejection; there is no assertion or showing of *independence*.

The alleged distinct inventions herein have not been shown to be *independent* as required by 37 CFR §1.142. In fact, claim 47 defines an aqueous fluid that if used in a method contemplated by the claims, the method would be that of claim 3. That is, a method such as that of claim 3 would necessarily use the aqueous fluid of claim 47, indeed there is much common language between these two claims. Other close similarities between the language of method claims 1-46 may be found with the language of composition claims 47-62 may be found. Thus, it is respectfully submitted that these two groups of claims are not independent from each other, but rather are intimately linked.

Further, the Examiner’s argument that the aqueous compositions of Group II as claimed can be used to practice another and materially different process, such as a viscous fluid in methods of well treatment or “out of the well treatment” is at best confusing, and respectfully submitted borders on non-sensical. Breaking a viscosity of an aqueous fluid gelled with a polysaccharide is *part of the same process* as a well treatment method, *e.g.* fracturing a subterranean formation. One having ordinary skill in the art does not simply gel aqueous fluids just to break them. The gelled aqueous fluid is used for a purpose, such as treating a well, and then the gel is broken so that the fluid is recovered. They are not “materially different process” – they are part of the *same* process. Furthermore, it is not know what the Examiner means when he asserts the aqueous fluid may be used “out of the well treatment”. The Applicant respectfully requests that the Examiner explain what this means – if aqueous fluids such as those recited in claims 47-62 may be used in another “materially different process” “out of the well treatment”, what is the process?

Finally, the fact that the claims of Groups I and II may fall into different search categories is irrelevant when considering the requirement of restriction. As the Commis-

sioner may from time to time reorganize the Art Groups, restrictions based upon this type of reasoning would allow the Commissioner to arbitrarily decide what is and is not subject to restriction. In other words, the division of art groups does not necessarily have anything to do with divisions of technology or inventions. When a particular art group gets to be too large, a logical area to divide the group is determined. This division does not necessarily define separate inventive areas, but is arbitrary. Using the Examiner's reasoning and the example above, a restriction could be required on one day because of the separation of art groups that could not have been requested the day before. It is respectfully submitted that the passage of time and the arbitrary division of art groups should not enter into the restriction requirement. This is not the intent or the proper application of the restriction requirement. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments and discussion presented above overcome the restriction requirement and place the claims in condition for allowance. Reconsideration of the restriction requirement, and consideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is also invited to call the Applicant's attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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